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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,781	09/02/1999	MASAYUKI CHATANI	450127-02160	4426
20999	7590	12/01/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			TRAN, THAI Q	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/388,781	CHATANI ET AL.	
	Examiner	Art Unit	
	Thai Tran	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 12-15 is/are allowed.
- 6) ☒ Claim(s) 10,11 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Sept. 9, 2005 has been entered.

Response to Arguments

2. Applicant's arguments filed Sept. 9, 2005 have been fully considered but they are not persuasive.

In re pages 7-8, applicants argue that Yuen fails to teach or suggest all the limitations of claim 10 because, by contrast, Figures 1 and 9 of Yuen show an arrangement in which a recording medium (video tape 40 in a VCR system 10) is provided on the side of a data transmitting apparatus (VCR system 10), not on the side of a data receiving apparatus (external device 73).

In response, the examiner respectfully disagrees. Yuen et al discloses in col. 22, lines 7-10 that **"Consequently, each indexing VCR 10 provides indexing capability for each of the user's index tapes. The user may transfer directories between the indexing VCRs"**. From the above passage, it is clear that the recording medium is on the side of a data receiving apparatus because the user can transfer directories between the indexing VCRs.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 10-11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuen et al (US 5,488,409) as set forth in the last Office Action.

Regarding claim 10, Yuen et al discloses a data transmitting apparatus (Fig. 9) for transmitting data to a data receiving apparatus, comprising:

means (the user may transfer directories between the indexing VCRs disclosed in col. 22, lines 7-10 and directory disclosed from col. 8, line 65 to col. 10, line 29) for transmitting data containing an ID of a particular recording medium, the ID transmitted by broadcast, wherein said particular recording medium is provided on the side of said data receiving apparatus (the user may transfer directories between the indexing VCRs disclosed in col. 22, lines 7-10). It is noted that broadcast can be defined as to make known over a wide area. The transferring directories between the indexing VCRs disclosed in col. 22, lines 7-10 of Yuen et al anticipates the claimed broadcast because it makes known over a wide area.

Regarding claim 11, Yuen et al further discloses the claimed wherein the transmitted data containing the name of a file in said particular recording medium and/or data identifying a recording area in said particular recording medium (the PROGRAM disclosed in col. 9, lines 48-67).

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Regarding claim 16, Yuen et al discloses the claimed means for broadcasting data control information to start a game program residing on said particular recording medium (directory disclosed from col. 8, line 65 to col. 10, line 29, baseball game disclosed from col. 31, line 64 to col. 32, line 6, and football game disclosed in col. 56, lines 57-64).

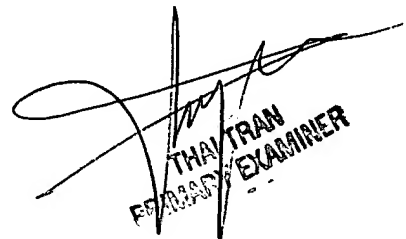
Allowable Subject Matter

5. Claims 1-9 and 12-15, as stated in the last Office Action, are allowed.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN
EXAMINER